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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,158	06/22/1999	THOMAS GEORGE KOTSIPOPOULOS	31145T	1031

7590 12/20/2002  
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EXAMINER	
KIM, EUGENE LEE	
ART UNIT	PAPER NUMBER

3721

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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**GROUP 3700**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20

Application Number: 09/338,158  
Filing Date: June 22, 1999  
Appellant(s): KOTSIPOULOS, THOMAS GEORGE

\_\_\_\_\_  
Mr. Dennis H. Ma  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11/5/2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 5-12 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4261497	Roetter et al	4-1981
4468912	Lewis et al	9-1984

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roetter et al (#4,261,497) in view of Lewis et al (#4,468,912). Roetter et al show the method of separating weakened areas by stopping the movement of feed rollers 22,24 while moving delivery rollers 38,40. The feed rollers are stopped with a brake clutch mechanism based on a sensed condition. This reads on a bursting movement as claimed. Roetter et al show the use of a photodetector sensing means 48 to sense a leading edge and cause the actuation of the bursting to take place. The bursting is performed with infeed rollers 22, 24 and outfeed rollers 38, 40. Roetter discloses that the apparatus of Roetter is relating to a bursting apparatus and more particularly to the separation of a continuous web of material along transverse lines of weakening (col 1 lines 1+). Roetter et al do not show the concept of supplying coupons into a particular location as claimed. Lewis et al teaches the basic concept of inserting coupons onto cartons. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Roetter et al with coupon inserting means as taught by Lewis et al to insert a desired product. Inherently, the coupon is being removed at the appropriate/predetermined time.

**(11) Response to Argument**

In response to applicant's argument that the references are not properly combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the primary reference, Roetter et al, disclose that the bursting apparatus is being used to separate a continuous web of material (col 1 lines 1+). Roetter et al further disclose that the continuous web of material is to be processed for ultimate use, such as, inserting (col 2 lines 60+). The secondary reference, Lewis et al, is being used to show the concept of separating a continuous web of coupons. Roetter et al teach that the web may be used for inserting and the method/apparatus of Roetter et al is fully capable of separating any type of continuous web, such as, the continuous web of coupons as taught by Lewis et al.

In response to applicant's argument that the references are not analogous, the examiner maintains that both references are analogous since both references are feeding a continuous web of material and separating the material into individual sections. As stated supra, Roetter discloses that the apparatus of Roetter is relating to a bursting apparatus and more particularly to the separation of a continuous web of material. Therefore, the examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Roetter et al with coupon

inserting means as taught by Lewis et al to separate a desired product from a continuous web of material.

In response to applicant's argument regarding the inserting of the coupons into a carton, the examiner first notes that the primary reference, Roetter et al, disclose ultimate use as folding or inserting the product (col 2 lines 60+). Furthermore, the secondary reference, Lewis et al disclose that the coupons are to be deposited to the location of the cartons (abstract) which infers that the location is predetermined. The examiner also notes that little patentable weight is given to location of parts, such as the location of where the coupons are inserted, unless there is some criticality or unexpected result from the location. See In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)

For the above reasons, it is believed that the rejections should be sustained.

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Art Unit: 3721

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Respectfully submitted,

  
Eugene Kim

December 11, 2002

Conferees

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